REMARKS

Applicant respectfully requests reconsideration and withdrawal of the rejection of the claims.

Prior to the present response, claims 1-56 were pending. By way of the above amendments, claims 37-48, 55 and 56 are canceled, and claims 57-76 are added. Accordingly, claims 1-36, 49-54 and 57-76 currently are pending. Applicant reserved the right to pursue the subject matter of non-elected claims 37-48, 55 and 56 in a divisional application.

Before proceeding with a detailed analysis of the Office Action, Applicant notes with appreciation the Examiner's allowance of claims 2, 4-6, 12-16, 22-36, 50 and 52-54. However, Applicant respectfully submits that all pending claims of the present application are in condition for allowance, for the following reasons:

Starting on page 3 of the Office Action, claims 1, 3, 9, 10, 11, 19, 20, 21, 49 and 51 are rejected under 35 U.S.C. 103 as allegedly being obvious over Applicant's Figures 7A, 7B and the description thereof on pages 2-3 of the application in view of pages 66-67 of Badih El-Kareh, "Introduction to VLSI Silicon Devices, Physics, Technology and Characterization," 1986, Kluwer Academic Press (hereinafter, "El-Kareh"). Applicant respectfully traverses this rejection.

In setting forth the rejection, the Examiner essentially asserts that Figures 7A and 7B, and pages 2-3 of Applicant's specification describe a conventional semiconductor element, which includes all the elements of the claims except for "forming a resist mask over the conductive film to etch and to shape the conductive film." It is respectfully submitted, however, that the processes described in connection with Figures 7A and 7B do not mention or suggest the combination of features set forth in claim 1, which include "etching a part of the conductive film by using the resist mask," and "etching a part of the etched conductive film."

The Examiner relies upon the notoriety in the art at the time of the invention and pages 66-67 of El-Kareh for teaching of using photolithography and selective etching in contact metallurgy. However, it is respectfully submitted that these secondary citations are too general because they do not address the specific features of claim 1 of "etching a part of the conductive film by using the resist mask," and "etching a part of the etched conductive

film."

El-Kareh and the Examiner's assertion of what is well known to one of ordinary skill in the art, therefore, fail to teach or suggest the combination of each and every feature recited in claim 1, whether these references are taken individually or in any combination. Hence, the rejection cannot stand because a *prima facie* case of obviousness has not been established. See MPEP Sections 2143, 2143.03, and the case law cited therein. Accordingly, the rejection of claim 1 should be withdrawn.

Similar distinctions are set forth in independent claim 3, which recites *inter alia* forming a conductive film over a semiconductor region after exposing a part of the semiconductor region, etching a part of the conductive film, forming a resist over the conductive film, removing a portion of the resist to form a resist mask, and etching a part of the conductive film by using the resist mask. As pointed out above, however, non of the references relied upon teach or suggest more than one etching of a conductive film. It is respectfully submitted, therefore, that claim 3 is allowable at least for reasons analogous to those given above with respect to claim 1.

Claims 9, 10, 11, 19, 20, 21, 49 and 51 either directly or ultimately depend from of independent claims 1 and 3, and are therefore allowable for at least the above reasons, and further for the additional recited features.

It is respectfully submitted that the combinations of features set forth in new claims 57-76 also are not taught or suggested by Applicant's description of a conventional semiconductor element, El-Kareh and the Examiner's assertions of what was well known in the art at the time of the invention. For example, independent claim 57 recites, among other claimed features, "etching a part of the conductive film by using the resist mask," and "etching a part of the etched conductive film." Independent claims 64 and 70 are directed to methods for manufacturing a semiconductor element that include "etching a part of the first conductive film by using the resist mask to form a second conductive film," and "etching a part of the second conductive film to form a source electrode and a drain electrode." By contrast, the conventional semiconductor element shown in Figures 7A and 7B of Applicant's description of the related art shows only formation of electrodes 709a, 709b. Furthermore, even if one of ordinary skill in the art were to consider, for the sake of argument, that the pages of El-Kareh were to suggest a step of photolithography to define a resist mask and then

selectively etching to form a conductive film, and that it is notoriously well known to do so, such teachings, even when combined with the conventional element of Figures 7A and 7B, would not have suggested the plural etching processes set forth in the new independent claims.

Additionally, new independent claims 57, 64 and 70 set forth combinations including additional features not taught or suggested by the references cited by the Examiner. For example, new claim 57 recites "etching a portion of the insulating film to expose a part of the semiconductor region and to form portions of the insulating film remaining on at least side surfaces of the gate electrode" and "said part of the semiconductor region is outside of the remaining portion of the insulating film." New claim 64 recites *inter alia* that each source electrode and drain electrode covers a side surface and an upper surface of the semiconductor region. New claim 70 recite, among other claimed features, "forming an interlayer insulating film over the source electrode and the drain electrode," "forming at least one connection wiring over the interlayer insulating film," and "said connection wiring is connected to one of the source electrode and the drain electrode through a hole of the interlayer insulating film." It is respectfully submitted that Applicant's description of a conventional semiconductor element, El-Kareh, and the Examiner's assertions of what was well known in the art, would not have taught or suggested such features in combination with the other claimed limitations. Hence, the new claims 57-76 are considered allowable.

While the present application is believed to be in condition for allowance, should the Examiner find any remaining issue that could be resolved by way of a telephonic conference, he is invited to contact the undersigned to arrange such a conference.

Allowance and prompt notification of the same is earnestly sought.

Respectfully submitted,

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